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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,403	02/04/2004	Timothy P. Murphy	010-001	2737

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CERMAK & KENEALY LLP
515 E. BRADDOCK RD
SUITE B
ALEXANDRIA, VA 22314

EXAMINER	
PREBILIC, PAUL B	

ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/770,403	MURPHY, TIMOTHY P.	
	Examiner	Art Unit	
	Paul B. Prebilic	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) 15-22 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-14 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 04 February 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 7/20/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to a method of treating obesity, classified in class 607, subclass 40 or class 623, subclass 23.64.

II. Claims 15-22, drawn to an endograft, classified in class 623, subclass 1.31.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product as claimed could be used in a materially different process such as in a process of constricting the blood flow in a pulmonary artery.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Adam Cermak on August 24, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claim 3 is objected to because of the following informalities:

In claim 3, on lines 2-3, the language of the Markush group "selected from the group consisting of . . . or both" is not consistent with accepted language. The "or" should be replaced with ---and---; see MPEP 2173.05(h) that is incorporated herein by reference. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Flesler et al (US 2002/0161414). Flesler anticipates the claim language where electrical stimulation is used to constrict the arteries leading to the small intestine; see paragraphs [0020], [0011], and [0113].

With regard to claims 2-3 and 8, the electrodes (200) of Flesler are devices placed around (i.e. in the area of) arteries of the small intestine including the superior mesenteric (110); see Figure 4. For this reason, the Examiner asserts that the claim language of claims 2-3 is read on by Flesler.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-6, 9-10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flesler et al (US 2002/0161414) in view of Ruiz (US 6,120,534). Flesler discloses a method of constricting the arteries leading to the small intestine with electrical stimulation but does not disclose placing an endograft inside the artery as claimed. However, Ruiz teaches that it was known to use physical restriction devices in arteries in order to restrict blood flow where needed; see the figures (particularly Figures 8A to 8C), the abstract, column 2, lines 5-58, and column 7, line 21 to column 8, line 16. Therefore, it is the Examiner's position that it would have been obvious to use the endograft device of Ruiz in conjunction with or in place of the electrical stimulation device of Flesler to provide a set degree of minimal constriction that can be varied with the electrical stimulation means or for the same reasons that Ruiz uses the same.

With regard to claims 5 and 6, Flesler teaches putting electrodes in arteries leading to the small intestine. Since the gastroduodelnal artery leads to the small intestine, the use of a constriction device therein is clearly suggested.

With regard to claim 12, Ruiz clearly teaches expanding the constrictor to adjust the amount of blood flow; see supra. For this reason, such would be obvious when utilized in Flesler's method.

With regard to claim 13, a "swellable material" is interpreted broadly to mean a material that is able to increase in size or expand in size or shape; see http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=186171

7507. Clearly the middle portion of the Ruiz device is a material that can be increased in size and shape; see *supra*.

With regard to claim 14, the Examiner asserts that it would have been obvious to manage pain or discomfort by adjusting the constriction in order to maximize the benefit of the device where utilized.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flesler et al (US 2002/0161414) in view of Edmunds, Jr. et al (US 3,730,186). Flesler discloses constricted small intestine artery diameters utilizing electrical stimulation but not with a band or ligature as claimed. However, Edmunds, Jr. teaches that it was known to utilize a ligature to constrict arteries within the artery constrictor art; see the abstract. Therefore, it is the Examiner's position that it would have been prima facie obvious to constrict the arteries of Flesler with the ligature of Edmunds in order to provide a means to constrict the vessels as a backup if the electrical stimulation systems fails.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flesler and Ruiz as applied to claims 4-6, 9-10, and 13-14 above, and further in view of Yurek et al (US 5,690,644). Flesler fails to disclose moving a sleeve over the endograft and removing the sleeve within the artery. However, Yurek teaches that it was known to utilize sleeves over stents with inner catheters; see Figure 1 and column 3, lines 46-58. Therefore, it is the Examiner's position that it would have been obvious to utilize a sleeve with the stent and catheter of Flesler for the same reasons that Yurek utilizes the same, in order reduce artery tissue damage during delivery or to better control expansion of the constrictor.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Prebilic
Primary Examiner
Art Unit 3738